REMARKS

Claims 1-23 are presently pending in the case. Claims 1 and 21-23 have been amended. Claims 1-23 remain in the case.

Claims 22 and 23 have been amended to correct a clerical error and is not for a reason related to patentability. Amended Claims 22 and 23 now depend from Claim 21, rather than from Claim 18. No new matter has been introduced.

Claim 1, 7, 11-19, 21 and 23 stand rejected under 35 U.S.C. 102(b) as anticipated by U.S. Patent No. 5,486,686 (Zdybel, Jr. et al.). A claim is anticipated under 35 U.S.C. 102(b) only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. MPEP § 2131. Applicant traverses the rejection. The Zdybel reference fails to describe, either expressly or inherently, each and every claim element of, and therefore does not anticipate, Claims 1, 7, 11-19, 21 and 23.

Claim 1 and 18 both recite generating lossy compressed image data with the scanned representation of the hardcopy document. Claim 21 recites an image compression module for generating lossy compressed image data with the scanned representation of the hardcopy document. Support for these elements can be found in the specification on page 7, lines 11-19.

The Zdybel reference, though, fails to disclose generating lossy compressed image data. Instead, Zdybel describes converting a document into an electronic bitmap representation and subsequently employing recognition software to convert the electronic representation into elemental textual and graphical encodings (Col. 7, line 66-Col. 8, line 1). The electronic representation is composed of probabilistic encodings, bitmap images, or some combination of the two (Col. 8, lines 23-29).

Claim 1 and 18 both further recite producing an authentication token with the lossy compressed image data with the authentication token including one of encrypted image data and hashed encrypted image data and the hashed encrypted image data including the lossy compressed image data and an encrypted hash of the lossy compressed image data. Claim 21 further recites an authentication token

generator for producing an authentication token with the lossy compressed image data with the authentication token including one of encrypted image data and hashed encrypted image data and the hashed encrypted image data including the lossy compressed image data and an encrypted hash of the lossy compressed image data. Support for these elements can be found in the specification on page 8, lines 1-16.

The Zdybel reference likewise fails to disclose producing an authentication token with the lossy compressed image data and instead describes encoding the bit-level digital data contents of the electronic document to convert the content into "glyph encodings," which are encodings representing distinctive markings with at least two distinguishable, machine-readable states (Col. 8, lines 40-47). The glyph encoding can be used to recover data that affects the appearance of a document and data that is not inferable from the appearance of the document alone (Col. 9, lines 46-53). The glyph encoded data includes machine-readable descriptions of data points for structured graphics, algorithms utilized for performing computations for spreadsheets and the like, hypertext pointer values, structural characteristics of the electronic source document, the document editor used to prepare the source document, the file name and storage location of the electronic source document, and audit-trail data for the electronic source document (Col. 10, lines 13-26). The glyph encodings are merged into an electronic document description file that causes the glyphs to be printed on the hardcopy output document (Col. 8, lines 47-50), rather than producing an authentication token, including one of encrypted image data and hash encrypted image data, as further recited in Claims 1, 18 and 21. Moreover, there is no teaching or suggestion of encryption or hashing with the lossy compressed image data in Zdybel, as would be required to produce an authentication token as further recited in Claims 1, 18 and 21.

Claim 1 has been amended to clarify the claimed invention and recites arranging in the memory the scanned representation of the hardcopy document with a digital encoding of the authentication token for rendering at a printer a

signed and authenticated hardcopy document. Claim 18 further recites arranging in the memory a digital encoding of the authentication data for rendering at a printer a label containing the digital encoding of the authentication data. Claim 21 has been amended to clarify the claimed invention and recites an encoding module for arranging the scanned representation of the hardcopy document with a digital encoding of the authentication token for rendering at a printer a signed and authenticated hardcopy document. Support for these elements can be found in the specification on page 8, lines 17-29.

Finally, the Zdybel reference fails to disclose arranging the scanned representation with a digital encoding of the authentication token for rendering at a printer a signed and authenticated hardcopy document and instead describes printing a human-readable rendering and digital machine-readable representation (Col. 8, lines 30-38) in the form of a paper document with encoded glyphs (FIG. 2A, Ref. Num. 102). Thus, the electronic document printing system of Zdybel fails to recite arranging in a memory both a scanned representation and a digital encoding, as further recited in Claims 1, 18 and 21.

In fact, Zdybel teaches away from Claims 1, 18 and 21 by describing the use of recognition software to extract semantic information in the form of bit-level digital data contents from a document (Col. 7, line 66-Col. 8, line 4). Zdybel creates the glyph encodings from the extracted semantic information (Col. 8, lines 41-48) and produces a machine readable digital representation and a human readable rendering on the same recording media using the same printing process (Col. 4, lines 45-51). In contrast, Claims 1, 18 and 21 merely use the literal scanned representation of a hard copy document in the form of a lossy compressed image. Semantic information is not extracted. Further, Claims 1, 18 and 21 each define authentication tokens produced using only the literal scanned representation and also recite generating lossy compressed image data, which is used to produce an authentication token that is arranged as a digital encoding with the scanned representation for rendering at a printer. In summary, forming authentication tokens is based only on the literal scanned representation in lossy

compressed form and does not require recognition software, as disclosed in the Zdybel reference.

Claims 7 and 11-17 are dependent on Claim 1 and are patentable for the above-stated reasons, and as further distinguished by the limitations recited therein. Similarly, Claim 19 is dependent on Claim 18 and is patentable for the above-stated reasons, and as further distinguished by the limitations recited therein. Similarly, Claim 23 is dependent on Claim 21 and is patentable for the above-stated reasons, and as further distinguished by the limitations recited therein. Accordingly, the Zdybel reference fails to described, either expressly or inherently, each and every claim element of Claims 1, 7, 11-19, 21 and 23. As Zdybel fails to anticipate Claims 1, 7, 11-19, 21 and 23, withdrawal of the rejection for anticipation is requested.

Claims 2-5, 20 and 22 stand rejected under 35 U.S.C. § 103(a) as obvious over Zdybel, Jr. et al. and further in view of U.S. Patent No. 5,157,726 (Merkle et al.). To establish a *prima facie* case of obviousness: (1) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine the reference teachings; (2) there must be a reasonable expectation of success; and (3) the combined references must teach or suggest all the claim limitations. MPEP § 2143. Applicant traverses the rejection. The Zdybel and Merkle references, taken either singly or in combination, fail to teach or suggest all the claim limitations and therefore do not render Claims 2-5, 20 and 22 obvious.

As described above with reference to the anticipation rejection of Claims 1-7, 11-19, 21 and 23, the Zdybel reference fails to teach or suggest all the claim elements. Claims 2-5 are dependent on Claim 1 and are patentable for the above-stated reasons, and as further distinguished by the limitations recited therein. Similarly, Claim 20 is dependent on Claim 18 and is patentable for the above-stated reasons, and as further distinguished by the limitations recited therein. Similarly, Claim 22 is dependent on Claim 21 and is patentable for the above-

stated reasons, and as further distinguished by the limitations recited therein. Accordingly, the Zdybel and Merkle references, taken as a whole, fail to teach or suggest the claimed subject matter of Claims 2-5, 20, and 22. As Zdybel and Merkle fail to render Claims 2-5, 20 and 22 obvious, withdrawal of the rejection for obviousness is requested.

Claims 6 and 8-10 stand rejected under 35 U.S.C. § 103(a) as obvious over Zdybel, Jr. et al., and further in view of U.S. Patent No. 5,706,099 (Curry). To establish a *prima facie* case of obviousness: (1) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine the reference teachings; (2) there must be a reasonable expectation of success; and (3) the combined references must teach or suggest all the claim limitations. MPEP § 2143. Applicant traverses the rejection. The Zdybel and Curry references, taken either singly or in combination, fail to teach or suggest all the claim limitations and therefore do not render Claims 6 and 8-10 obvious.

As described above with reference to the anticipation rejection of Claims 1-7, 11-19, 21 and 23, the Zdybel reference fails to teach or suggest all the claim elements. Claims 6 and 8-10 are dependent on Claim 1 and are patentable for the above-stated reasons, and as further distinguished by the limitations recited therein. Accordingly, the Zdybel and Curry references, taken as a whole, fail to teach or suggest the claimed subject matter of Claims 6 and 8-10. As Zdybel and Curry fail to render Claims 6 and 8-10 obvious, withdrawal of the rejection for obviousness is requested.

The prior art made of record and not relied upon has been reviewed by the applicant and is considered to be no more pertinent than the prior art references already applied.

Claims 1-23 are believed to be in a condition for allowance. Entry of the foregoing amendments is requested and a Notice of Allowance is earnestly solicited. Please contact the undersigned at (206) 381-3900 regarding any questions or concerns associated with the present matter.

Amendment and Response to First Office Action
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Respectfully submitted,

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